

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 43 (90/003,346)  
Paper No. 33

(90/003,873)

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte PETROLITE CORP.

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Appeal No. 97-2787  
Reexamination Nos. (90/003,346<sup>1</sup>)  
and (90/003,873)<sup>2</sup>

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HEARD: August 5, 1997

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Before WILLIAM F. SMITH, PAK and WALTZ, Administrative Patent Judges.

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<sup>1</sup> Merged reexamination proceeding for U.S. Patent No. 5,074,991, issued December 24, 1991, to Jerry J. Weers, and based on Application No. 07/525,796, filed May 18, 1990, which appellant states is a continuation-in part of Application No. 07/310,420, filed February 13, 1989, now abandoned. Reexamination request filed February 28, 1994.

<sup>2</sup> Merged reexamination proceeding for U.S. Patent No. 5,074,991, issued December 24, 1991, to Jerry J. Weers, and based on Application No. 07/525,796, filed May 18, 1990, which appellant states is a continuation-in-part of Application No. 07/310,420, filed February 13, 1989, now abandoned. Reexamination request filed June 23, 1995.

PAK, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellant has filed a request for rehearing of our decision mailed December 13, 1998<sup>3</sup>. See Request, page 1. This request is directed to only our affirmance of the examiner's decision rejecting claims 1 through 9 and 17 through 22 under 35 U.S.C. § 103 as unpatentable over the teachings of the Doerges reference.

We have carefully considered the arguments raised by appellant in the request for rehearing. However, we are not persuaded that our decision was in error in any respect.

In the request, appellant lists two points believed to have been misapprehended or overlooked in rendering our decision. We will address each of these points in the order they are presented in the request.

First, appellant argues that we overlooked the difference between the removal of hydrogen sulfide as taught by the Doerges reference and the inhibition of hydrogen sulfide as

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<sup>3</sup> The correct mailing date of the decision is October 13, 1998.

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called for by claims 1 through 9 and 17 through 22.<sup>4</sup> We do not agree.

As indicated at page 14 of the decision, claims 1 through 9 are directed to a process **comprising**

adding to the material a sufficient amount of the particular diaminomethane compound defined by the claimed formula to inhibit hydrogen sulfide gas evolution.

Although the process may require "**some** suppression or inhibition of the generation of hydrogen sulfide gases," it does "not preclude the removal of hydrogen sulfide gases" to suppress evolution of hydrogen sulfide from the system described in the Doerges reference. See pages 14 and 15 of the decision. We found at pages 19 and 20 of the decision that the Doerges reference, like the claimed process, describes adding to a hydrocarbon containing hydrogen sulfide the claimed sufficient amount of the particular diaminomethane compound. See pages 17 and 18 of the decision regarding claim interpretation together with pages 19 and 20 of the decision.

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<sup>4</sup> Appellant has ignored the fact that claims 17 through 22 are directed to a product, not a process. Appellant does not dispute our factual findings at pages 32, 36 and 37 of the decision that the Doerges reference or the Kaspaul reference describes the claimed composition.

In other words, the Doerges reference fully describes the claimed process, except for the recognition that it imparts an additional benefit, i.e., causes some suppression of hydrogen sulfide. See pages 19 and 20 of the decision. However, as we pointed out at page 20 of the decision, the mere recognition of such an additional benefit in the process described in the Doerges reference does not impart patentability. ***See In re Woodruff***, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990)("merely discovering and claiming a new benefit of an old process cannot render the [old] process again patentable").

Second, appellant argues that we overlooked the difference between the specific amount of the particular diaminomethane compound recited in claims 2, 4 and 6 through 9 and the amount of the particular diaminomethane compound described in the Doerges reference.<sup>5</sup> For the reasons set

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<sup>5</sup> Appellant alleges for the first time that his new calculation that took into consideration of the amount of a hydrocarbon material present in Doerges' system demonstrates that the Doerges reference describes using the particular diaminomethane compound in an amount which is far greater than that claimed. Not only is this allegation unsupported by any factual evidence, but this allegation is also inconsistent with appellant's own initial calculation (64,000 ppm to 640,000 ppm). When an additional amount of an additional material (hydrocarbon) is present in a mixture, the proportion

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forth at pages 28 through 30 of the decision, we do not agree with appellant's argument. Note particularly appellant's own evidence which indicates that the Doerges reference describes the claimed amount of the claimed diaminomethane compound.

In light of the foregoing, appellant's request for rehearing is granted to the extent of reconsidering our decision, but is denied with respect to making any change thereto.

REQUEST FOR REHEARING-DENIED

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of the diaminomethane compound therein must decrease (not increase as alleged by appellant). Compare, for example, appellant's initial calculation of 64,000 ppm without considering the amount of a hydrocarbon material present in Doerges' system with appellant's subsequent calculation of 129,000 ppm to about 368,000 ppm, when the amount of a hydrocarbon material in Doerges' system was allegedly considered.

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WILLIAM F. SMITH	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
CHUNG K. PAK	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
THOMAS A. WALTZ	)	
Administrative Patent Judge	)	

CKP:lp

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APJ PAK

APJ WALTZ

APJ WILLIAM SMITH

REQUEST FOR REHEARING-DENIED

Send Reference(s): Yes No  
or Translation (s)

Panel Change: Yes No

Index Sheet-2901 Rejection(s): \_\_\_\_\_

Prepared: September 9, 1999

Draft      Final

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PALM / ACTS 2 / BOOK  
DISK (FOIA) / REPORT